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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 94

Application Number: 08/303,561

Filing Date: September 09, 1994

Applicants: Johannes G. Bednorz et al.

Examiner M. Kopec

Daniel P. Morris
For Appellant

**THIRD SUPPLEMENTAL APPELLANT'S REPLY
TO THE EXAMINER'S ANSWER**

Appellant's SUBSTITUTE SUPPLEMENTAL APPELLANT'S REPLY TO THE EXAMINER'S ANSWER TEXT ONLY, submitted on August 24, 2000, refers to Attachment C that contains a Table 1 of high Tc materials from the "CRC Handbook of Chemistry and Physics" 2000-2001 Edition. Table 1 lists 7 references as the source of the information on the 42 high Tc materials in Table 1. Those references are listed below. The books corresponding to Attachments E (Vols. I and II), F, H and I were submitted with Appellants' SECOND SUPPLEMENTAL REPLY TO EXAMINER'S ANSWER submitted on October 6, 2000, received by Technology Center 1700 on October 10, 2000. The books corresponding to Attachment E (Vol. III) and Attachment G are submitted herewith. A photocopy of Attachment E (Vol. III) is submitted herewith since although Appellants' have ordered this book from the publisher some time ago, it is not clear that the publisher intends on reprinting this book, which if received will be submitted to the USPTO.

1. Attachment E
Ginsberg, D.M., Ed., Physical Properties of High-Temperature Superconductors, Vols. I-III, World Scientific, Singapore, 1989-1992.
2. Attachment F
Rao, C.N.R., Ed., Chemistry of High-Temperature Superconductors, World Scientific, Singapore, 1991.
3. Attachment G
Shackelford, J. F. and Alexander, W., CRC Materials Science and Engineering Handbook, CRC Press, Boca Raton, 1992, 98-99 and 122-123.
4. Attachment H
Kaldis, E., Ed., Materials and Crystallographic Aspects of HTc-Superconductivity, Kluwer Academic Publ., Dordrecht, The Netherlands, 1992.
5. Attachment I
Malik, S.K. and Shah, S.S., Ed., Physical and Material Properties of High Temperature Superconductors, Nova Science Publ., Commack, N.Y., 1994.
6. Attachment J
Chmaissem, O. et al., Physica C230, 231-238, 1994
7. Attachment K
Antipov E. V. et al., Physica C215, 1-10, 1993, 231-238, 1994

The is no evidence in these references that the 42 high T_c materials of Attachment C cannot be made following appellants' teaching.

SUMMARY OF THE QUESTIONS RAISED BY THIS APPEAL

A number of Appellants' claims have been rejected under 35 USC 112, first paragraph, as not enabled by Appellants' specification. The Examiner has given these reasons in support of this rejection: 1) the Examiner's unsupported statements that the art of high T_c superconductivity is unpredictable; 2) the Examiner's unsupported statement that the theory of high T_c superconductivity is not well understood; and 3) the

Examiner points to examples cited in Appellants' specification which do not show superconductivity greater than 26°K. The Examiner has provided no support for reasons 1 and 2 in response to Appellant's request that the Examiner provide evidence in support thereof or an Examiner's Affidavit in support thereof as required by 37 CFR 104(d)(2). The Examiner provided neither. Thus, reasons 1 and 2 are the Examiner's unsupported opinion and therefore reasons 1 and 2 should be disregarded by the Board. Appellant's examples that do not have a $T_c > 26^\circ\text{K}$ (Reason 3) do not support the Examiner's lack of enablement rejection in view of the decisions cited by Appellants, in particular, *In re Angstadt*, *Amgen v. Chugai Pharmaceutical Co.* and *In re Wands*. Appellants have provided extensive evidence in support of their view that their claims are enabled: 1) the five affidavits of Tzui, Dinger, Duncombe, Shaw and Mitzi, 2) the books and articles cited in these affidavits, 3) the book of Poole that states that the reason so much work was done in such a short period of time after Appellants' first discovery was that the high T_c materials were easy to make using well known fabrication techniques, 4) the article of Rao et al. entitled "Synthesis of Cuprate Superconductors" which cite numerous species of high T_c materials which can be made according to Appellants' teaching and 5) the CRC Handbook of Chemistry and Physics which cites numerous species of high T_c materials which can be made according to Appellants' teaching. Many of the species in 4 and 5 are not specifically recited in Appellants' specification, but they come within the genus of Appellants' claims that have been rejected as not enabled. Moreover, there is no evidence of record that a person of skill in the art cannot, without undue experimentation, make these species following Appellants' teaching. The Examiner has not denied that Appellants' extensive proof shows that a person of skill in the art can fabricate these species following Appellants' teaching. Under *In re Angstadt* and *In re Wands* it is Examiner's burden to establish that undue experimentation is needed to practice Appellants' claimed invention. The Examiner has made no attempt to satisfy this burden.

As stated all of Appellants' claims except for one was rejected in the final rejection as anticipated or obvious over the Asahi Shinbum article under 35 USC 102 and 103. In the Examiner's Answer, these rejections were found moot in view of the

new Examiner agreeing that Appellants effectively swore behind the date of this article as alleged by Appellants earlier in the prosecution of this application. The Examiner has not withdrawn the 35 USC 102 and 103 rejections. Thus as alleged by Appellants from very early in the prosecution of this application, by these rejections, the Examiner has necessarily and unambiguously found all of Appellants' claims enabled. As stated, the Asahi Shinbum article derives its enablement from Appellants' publication which was published less than a year before Appellants' filing date and which is incorporated by reference in Appellants' specification. For a reference to anticipate a claimed invention the reference must enable from the teaching therein a person of skill in the art to practice the alleged anticipated claims and for a single reference to render obvious a claimed invention the single reference must enable a person of skill in the art to practice the alleged obvious claims from the teaching of that reference in combination with what is know to a person of skill in the art. Thus, all of Appellants' claims that were rejected under 35 USC 102 and 103 over the Asahi Shinbum article must be fully enabled by the Examiner's own rational.

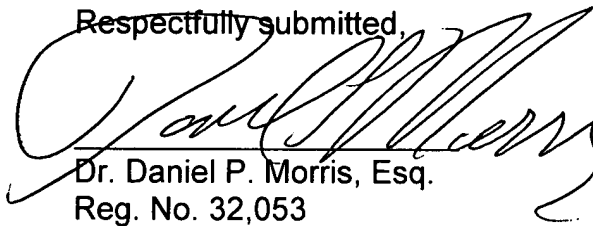
Section 104(b)(3) of 37 CFR states "[i]n rejecting claims the examiner may rely upon admissions by the applicant ... as to any matter affecting patentability". Thus, if Appellant in rebutting the 35 USC 112 rejections made statements adverse to their interests in regards to rebutting the rejections under 35 USC 102 and 103, the Examiner could use these statements to assert that Appellants admitted that their invention was anticipated or obvious. Likewise, if Appellant in rebutting the 35 USC 102 and 103 rejections made statements adverse to their interest in regards to rebutting the rejections under 35 USC 112, the Examiner could use these statements to assert that Appellants admitted that their claims were not enabled or were indefinite. Section 104(b)(3) does not explicitly apply to the Examiner. Not to apply the rational of 37 CFR 104(b)(3) to the Examiner to find that the necessary consequences of the Examiners 35 USC 102 and 103 rejections are that all of the Appellants' claims are enabled would be manifestly unfair and inequitable.

Appellants' claims have been rejected under 35 USC 112, second paragraph, as indefinite for using language of the type "rare earth like" and "pervskite-like", etc. As shown by Appellants, the claims of many issued US Patents use such terms. The Examiner has arbitrarily rejected Appellants' claims without providing a reason for why Appellants' terms are indefinite while similar terms are not indefinite in the claims of these many issued patents.

Appellants request the Board to reverse the examiners rejections of claims under 35 USC 112, first paragraph and second paragraph.

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Respectfully submitted,



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